



Paper No. 9

GLAXOSMITHKLINE
Corporate Intellectual Property - UW2220
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MAR 3 1 2003

OFFICE OF PETITIONS

In re Application of :
Hatton et al. :
Application No. 10/032,403 : **ON PETITION**
Filed: December 20, 2001 :
Attorney Docket No. P32162C1 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 6, 2003 (certificate of mailing date March 3, 2003), to revive the above-identified application. In addition, the decision will address the petition under 37 CFR 1.47(a), filed October 16, 2002 (certificate of mailing date October 11, 2002).

The petition under 37 CFR 1.137(b) is **granted**.

The petition under 37 CFR 1.47(a) is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

PETITION UNDER 37 CFR 1.137(b)

This application became abandoned for failure to timely reply to the Notice to File Missing Parts of Application mailed June 11, 2002, which set forth an extendable two (2) month period to submit the required payment of a \$130.00 surcharge under 37 CFR 1.16(e), an executed oath or declaration, and an abstract beginning on a separate sheet.

On October 16, 2002 (certificate of mailing date October 11, 2002), a petition for a two month extension of time and authorization to charge the required fee, a declaration signed by one of the two joint inventors, authorization to charge the surcharge and Rule 47 petition fee, and the instant Rule 47 petition were filed. However, petitioner failed to file an abstract. As a result, this

application became abandoned on October 12, 2002. The filing of the instant petition precedes the mailing of a Notice of Abandonment.

Having submitted an acceptable abstract, the petition fee for revival under the unintentional standard, and an acceptable statement of unintentional delay, the petition under 37 CFR 1.137(b) is granted.

PETITION UNDER 37 CFR 1.47(a)

The above-identified application was filed on December 20, 2001 without an executed oath or declaration. Accordingly, on June 11, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration, a surcharge for its late filing, and an abstract.

In response, October 16, 2002 (certificate of mailing date October 11, 2002), a petition for a two month extension of time and authorization to charge the required fee, a declaration signed by one of the two joint inventors, authorization to charge the surcharge and Rule 47 petition fee, and the instant Rule 47 petition were filed. The petition and accompanying exhibits establish that non-signing joint inventor, Dr. Ian Hatton received a copy of the application as filed, a declaration, and an assignment, but he refused to sign the declaration for the patent application unless he received additional compensation.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (2) above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration must contain each inventor's post office address. This address should be the place where the inventor customarily receives mail. MPEP 605.03.

The petition states that the last known address of Dr. Hatton is not GlaxoSmithKline's Pennsylvania address, but rather a residential address in England. In fact, Dr. Hatton no longer works for GlaxoSmithKline, so he clearly does not receive mail there. Petitioner must submit another declaration that lists the post office/mailing address for both inventors. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicant (Mr. Pearson) on behalf of Dr. Hatton is REQUIRED. See MPEP 409.03(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
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Telephone inquiries should be directed to the undersigned at (703) 308-6712.



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